

REMARKS

The present remarks are in response to the Final Office Action dated March 31, 2006, in which the Examiner rejected claims 1-6, 8-12, and 14-19.

The Applicant respectfully responds to the Examiner's Detailed Action and requests the Examiner to place all pending claims detailed in the application in a state of allowance.

A. Summary of Examiner's Office Action

In the Examiner's final rejection, the Examiner admits that the combination of Oda in view of Toyoda does *not* disclose that the second side surface of the device be concave. See Office Action dated 3/31/06, pp. 6, 7. The Examiner then continues to argue that:

... notwithstanding applicant's contention that there is no motivation to modify Oda or Toyoda's portable phone, one of ordinary skill in the art would be motivated to modify Oda portable telephone set to have concave side surface on which speaker and microphone are located because Ohnsorge teaches a portable telephone having a concave surface on which speaker and microphone are located ... so that this concave shape of the side surface of the portable telephone in which microphone and speaker located would result in better intelligibility to the user when using the portable telephone as taught by Ohnsorge See Office Action dated 3/31/06, p. 6 (emphasis added).

The Examiner then continues to repeat general theme that Ohnsorge has a concave surface to ensure good "intelligibility."

Repeatedly, the Examiner's Office Action relies on the meaning or interpretation of the Ohnsorge patent and the meaning of "intelligibility," which is only referred to one time in the Ohnsorge '504 patent, and in the context of a phrase that states "to ensure good intelligibility." See col. 2, line 10-11, in Ohnsorge '504. Applicant researched the meaning of the term "intelligibility" at the website

www.dictionary.com and it stated that intelligibility is a noun meaning "the quality of language that is comprehensible."

B. Prior Art Rejections (35 U.S.C. §103)

The Examiner has rejected claims 1-2, 4-6, 8, and 10-12 under 35 U.S.C. §103 as being unpatentable over Japanese Patent Reference No. 2003-032342A to Oda Tetsuya (hereinafter referred to as "Oda"), in view of U.S. 5,485,504 to Ohnsonrge (hereinafter referred to as "Ohnsorge"). Additionally, the Examiner's rejection is a *final rejection*.

Applicant respectfully disagrees.

The Applicant submits that the independent claims 1, 8 and 14 each include, *inter alia*, the limitation that a communication device comprise "a housing including ... a second side surface being concave to generally follow a contour of a user's face." In order to establish a *prima facie* obviousness rejection, the Examiner's prior art must teach or suggest *all* claim limitations.

However, Oda and Ohnsorge, alone or in combination, do not describe or suggest a communication or wireless device having a second side surface being concave to follow the contour of a user's face, as recited in the amended independent claims.

Recall, Ohnsorge only describes "good intelligibility," and not a structural limitation such as following the contour of the user's face with a second side surface. "Intelligibility" is *not* a structural limitation, it is used to describe a "quality" that is associated with language. Additionally, "ensuring good intelligibility" is the goal of any communications device.

The hypothetical person of ordinary skill in the art is not defined by as one who is deemed to be aware of all relevant prior art or literature. *Heliflix Ltd. v. Blok-Lok, Lt.*, 208 F.3d 1339, 54 USPQ2d 1299, 1304 (Fed. Cir. 2000). Rather, he or she is defined by considering the education level of the inventor, the type of problems encountered in the art, the prior art solutions to these problems, the rapidity with which innovations are made, the sophistication of technology, and the education level of workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 1005, 1009, 217 USPQ 193, 196 (Fed. Cir. 1986).

Nowhere is ordinary skill in the art defined as being associated with a "quality" or goal such as "intelligibility." Additionally, a "quality" or goal does not rise to standard of a structural limitation, i.e. second side surface being concave to follow a contour of a user's face.

Additionally, FIG. 2 of Ohnsorge only shows that the front surface of radiotelephone, instead of the side surface, is not integrally flat. In fact, the front surface which is illustrated in FIGs. 1 and 2 of Ohnsorge includes three distinct segments. Each segment may be considered as having approximately a flat plane, i.e., a first flat segment housing the speaker, a second segment holding the lens, the video display and keypad, and a third segment housing the microphone.

In Applicant's case, the amended claims 1, 8 and 14 recite that the side surface of communication device is concave to follow the contour of a user's face and as an exemplary case, Fig. 3 of Applicant's Specification, shows the contour of the side surface is concave rather than having distinct flat segments, as shown Ohnsorge. Therefore, Ohnsorge does not even disclose a concave surface.

However, even if we were to assume, *arguendo*, that Ohnsorge does describe a concave surface, which Applicant denies, one skilled in the art would not be motivated to combine the teachings of Ohnsorge with Oda's to arrive at Applicant's claim, namely, having a second side surface which is concave to generally follow a contour of a user's face. The purpose in Oda is to make sure that the device does not come into contact with the face of a user (see Oda, Abstract). Oda mentions that the problem to be solved is to provide a portable phone having a large sized display in a small size portable phone body, wherein the display would not be in contact with the face of a user during its use, preventing it from becoming dirty due to the close proximity of a user's face with the device.

If we were to follow the reasoning that one skilled in the art would combine Oda with Ohnsorge, this would be wholly inappropriate. Ohnsorge is a reference that teaches away from what is taught in Oda. Having, as the Examiner states, "an arrangement provid[ing] necessary shape to ensure good intelligibility of telephone communications" would also ensure that a user's face would come in closer contact with a display due to this shape or arrangement. This, in turn, would exacerbate, if not cause, exactly the very technical problem what Oda is trying to avoid, namely, keeping the display area clean. Therefore, one skilled in the art, knowing the teachings of both Oda and Ohnsorge, would not have been motivated at all to combine these references to arrive at Applicant's claims because the references are contradictory and teach away from each other.

The Examiner also rejected claims 3 and 9 under 35 U.S.C. §103 as being unpatentable over Oda in view of Ohnsorge as applied to claim 1, 8, and in further view of U.S. 2002/0160725A1 to Toyota (hereinafter referred to as "Toyota"). The

Examiner further rejected claims 14-19 as well as being unpatentable over Odo in view of Toyoda and Ohnsorge.

Since claims 3, 9, 14-19 each include, *inter alia*, the limitation that a communication device comprise "a housing including ... a second side surface being concave to generally follow a contour of a user's face," Applicant submits that the cited references do not teach or suggest all the claim limitations of claims 3, 9, 14-19.

Therefore, none of the references, alone or in combination, describe or suggest a communication or wireless device having a second side surface being concave to follow the contour of a user's face, as recited in the independent claims.

The Federal Circuit has warned that "the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome where that which only the invention taught is used against its teacher." *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004). The Office Action relies upon a variety of features of a variety of references, which could only be done when the claims of the present application are, impermissibly, used as a guide.

Examiners must show where the prior art provides a motivation to combine the references they have combined in the obviousness rejection. Not only is such a requirement found in the case law which is binding upon the office, the MPEE §2143 also sets forth a similar requirement:

To establish a *prima facie* case of obviousness, three based criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or

suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vacek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As pointed out above, in the present case, none of the three criteria are met. The Office Action has not identified any suggestion from the prior art to modify the references. There is no reasonable expectation of success. To the contrary, since the teachings of the prior art are generally contradictory, as pointed out above, one of ordinary skill would be disinclined to combine the references and would have no reasonable expectation of success. Finally, as also pointed out above, there are certain claim elements which are simply not found in the prior art. For at least these reasons, Applicant respectfully requests withdrawal of the finality of the rejections based upon obviousness.


Applicant submits that all of the claims are allowable over the combination of the cited reference as none of the above references, alone or in combination, suggest or describe the aforementioned features recited in Applicant's claims. The limitations of claims 1-2, 4-6, 8, 10-12, and 14-19 are not taught or suggested by the prior art cited, and claims 1-2, 4-6, 8, 10-12, and 14-19 are now patently distinct and in condition for allowance, which action is respectfully requested.

C. Conclusion

For all the foregoing reasons, allowance of all pending claims is respectfully requested. . If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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